

## **REMARKS/ARGUMENTS**

### **Status Of Application**

Claims 1-20 are pending in the application; the status of the claims is as follows:

Claims 13-20 are withdrawn from consideration.

Claims 1-3, 5, 7, 8, and 10-12 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,869,420 to Naito ("Naito").

Claim 9 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Naito as applied to claims 1-3, 5, 7, 8, and 10-12 above, in view of U.S. Patent No. 5,922,528 to Weaver et al ("Weaver").

Claims 4 and 6 are objected to as being dependent upon a rejected base claim but would be allowable if rewritten in independent form including all of the limitations of the base claim and intervening claims.

The acknowledgement, in the Office Action, of a claim for foreign priority under 35 U.S.C. § 119(a)-(d), and that the certified copy of the priority document has been received, is noted with appreciation.

To date, no Notice of Draftsperson's Patent Drawing Review has been received. Applicant(s) respectfully request receipt of this document when it becomes available. Please note that the original drawings filed in the patent application are "formal" drawings.

### **Claim Amendments**

Claims 1, 5, 6, 10 and 12 have been amended to more particularly specify the claimed invention. These changes are not necessitated by the prior art, are unrelated to the patentability of the invention over the prior art, and do not introduce any new matter.

**35 U.S.C. § 102(b) Rejection**

The rejection of claims 1-3, 5, 7, 8, and 10-12 under 35 U.S.C. § 102(b) as being anticipated by Naito, is respectfully traversed based on the following.

Naito shows a rewritable thermal recording medium and a process for writing and erasing that medium. The medium consists of a color former and a developer, and may include a matrix agent and/or a phase separation controller (column 9, lines 31-37). The medium has a stable amorphous state at room temperature (column 3, lines 37-39). Recording is selectively performed by raising the temperature of the medium to a temperature greater than the crystallization temperature  $T_c$ , but less than the melting point  $T_m$  (column 3, line 39-44). Crystallization of the medium causes a phase separation of the color former and the developer, thus causing decolorization (column 3, lines 59-67). Heating the medium above the melting point  $T_m$ , returns the medium to an amorphous state. The sole colorization mechanism discussed in Naito is the reaction between the color former and the developer and the medium of Naito is only capable of holding a colored or uncolored state.

In contrast to the cited reference, claim 1 includes:

(a) heating the liquid crystal material contained in a first region of the thermosensitive image bearing medium at a first temperature for a first time period by applying a first energy, thereby causing the first region to change from a base color to a first color; and

(b) heating the liquid crystal material contained in a second region of the thermosensitive image bearing medium at a second temperature for a second time period by applying a second energy, thereby causing the second region to change to a second color, the second color being different from the first color, the first temperature being higher than the second temperature and the first time period being shorter than the second time period, ...

As noted above, Naito only shows a medium capable of a colored or uncolored state. The color is fixed by the color former/developer combination. In contrast, using the method of claim 1, the medium can be written with at least a first and second color on a

base color. The cited reference does not show or suggest writing to a “first region to change from a base color to a first color” and writing to a “second region to change to a second color, the second color being different from the first color.” To anticipate, a reference must show, expressly or inherently, every limitation of the claim. MPEP §2131. Therefore, the cited references do not anticipate claim 1. Claim 2, 3, 5, 7, 8, and 10-12 are dependent upon claim 1, and thus include every limitation of claim 1. Therefore, claims 2, 3, 5, 7, 8, and 10-12 are also not anticipated by claim 1.

Accordingly, it is respectfully requested that the rejection of claims 1-3, 5, 7, 8, and 10-12 under 35 U.S.C. § 102(b) as being anticipated by Naito, be reconsidered and withdrawn.

### **35 U.S.C. § 103(a) Rejection**

The rejection of claim 9 under 35 U.S.C. § 103(a), as being unpatentable over Naito as applied to claims 1-3, 5, 7, 8, and 10-12 above, in view of Weaver, is respectfully traversed based on the following.

Weaver shows controlling the number of pulses in a signal having a fixed voltage and pulse width to control the application of energy using that signal.

As noted above, Naito does not show or suggest writing to a “first region to change from a base color to a first color” and writing to a “second region to change to a second color, the second color being different from the first color.” Weaver does include the limitations missing in Naito. To show *prima facie* obviousness, every limitation of a claim must be shown or suggested in the references, singularly or in combination. MPEP §2143.03. Claim 9 is dependent upon claim 1 and thus includes every limitation of claim 1. Thus, the cited references do not support a *prima facie* case for obviousness of claim 9.

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Accordingly, it is respectfully requested that the rejection of claim 9 under 35 U.S.C. § 103(a) as being unpatentable over Naito as applied to claims 1-3, 5, 7, 8, and 10-12 above, in view of Weaver, be reconsidered and withdrawn.

#### **New Claims 21 and 22**

New claims 21 and 22 correspond to previously presented claims 4 and 6 rewritten in independent form including every limitation of the claims from which claims 4 and 6 depended. As noted in the Office Action in Item 5 on page 4, claim 4 and 6 would be allowable if rewritten in independent form. Therefore, claims 21 and 22 are allowable.

#### **CONCLUSION**

Wherefore, in view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and an early reconsideration and a Notice of Allowance are earnestly solicited.

This Amendment increases the number of independent claims by 2 from 2 to 4 and increases the total number of claims by 2 from 20 to 22, but does not present any multiple dependency claims. Accordingly, a Response Transmittal and Fee Authorization form authorizing the amount of \$122.00 to be charged to Sidley Austin Brown & Wood LLP's Deposit Account No. 18-1260 is enclosed herewith in duplicate. However, if the Response Transmittal and Fee Authorization form is missing, insufficient, or otherwise inadequate, or if a fee, other than the issue fee, is required during the pendency of this application, please charge such fee to Sidley Austin Brown & Wood LLP's Deposit Account No. 18-1260.


Any fee required by this document other than the issue fee, and not submitted herewith should be charged to Sidley Austin Brown & Wood LLP's Deposit Account No. 18-1260. Any refund should be credited to the same account.

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If an extension of time is required to enable this document to be timely filed and there is no separate Petition for Extension of Time filed herewith, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) for a period of time sufficient to enable this document to be timely filed.

Any other fee required for such Petition for Extension of Time and any other fee required by this document pursuant to 37 C.F.R. §§ 1.16 and 1.17, other than the issue fee, and not submitted herewith should be charged to Sidley Austin Brown & Wood LLP's Deposit Account No. 18-1260. Any refund should be credited to the same account.

Respectfully submitted,

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